

REMARKS

Claims 31-45 and 68 are pending.

The Applicants thank the Examiner for the telephone discussions held on March 20, 2009 and March 23, 2009 between the Examiner and the undersigned in which the claims were discussed. In those discussions, agreement was not reached.

The rejections under 35 U.S.C. §102

Claims 31-45 and 68 were rejected as being anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 5,271,940 (Cleary).

Claim 31 has been amended so as to be directed to a device for transdermal delivery “comprising” the recited compound of Formula I. The use of the word “comprising” means that the recited compound of Formula I must be present in a device for transdermal delivery in order for such a device to come within the scope of amended claim 31. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F. 3d 495, 501, 42 U.S.P.Q. 2d 1608, 1633 (Fed. Cir. 1997): “Comprising is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.”

Claim 45 has been amended in a similar manner to recite that the claimed device “comprises the free base of (R)-2-[3-(1,1-diisopropylamino)-1-phenylpropyl]-4-(hydroxymethyl)phenyl isobutyrate.” Thus, in order to come within the scope of

amended claim 45, a device for transdermal delivery must contain the free base of (R)-2-[3-(1,1-diisopropylamino)-1-phenylpropyl]-4-(hydroxymethyl)phenyl isobutyrate.

All the remaining claims depend, directly or indirectly, from amended claim 31. Thus, all the remaining claims also require the compound of Formula I recited in amended claim 31 or a compound within the genus defined by Formula I.

Cleary does not disclose the compound of Formula I recited in claim 31, a compound within the genus defined by Formula I, or the free base of (R)-2-[3-(1,1-diisopropylamino)-1-phenylpropyl]-4-(hydroxymethyl)phenyl isobutyrate. Thus, Cleary does not anticipate amended claims 31-45 and 68.

Accordingly, it is respectfully requested that this rejection be withdrawn.

Claims 31-45 and 68 were rejected as being anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 4,675,009 (Hymes).

Hymes does not disclose the compound of Formula I recited in claim 31, a compound within the genus defined by Formula I, or the free base of (R)-2-[3-(1,1-diisopropylamino)-1-phenylpropyl]-4-(hydroxymethyl)phenyl isobutyrate. Thus, Hymes does not anticipate amended claims 31-45 and 68.

Accordingly, it is respectfully requested that this rejection be withdrawn.

Claims 31-45 and 68 were rejected as being anticipated under 35 U.S.C. §102(a) by U.S. Patent No. 6,425,892 (Southam).

Southam does not disclose the compound of Formula I recited in claim 31, a compound within the genus defined by Formula I, or the free base of (R)-2-[3-(1,1-diisopropylamino)-1-phenylpropyl]-4-(hydroxymethyl)phenyl isobutyrate. Thus, Southam does not anticipate amended claims 31-45 and 68.

Accordingly, it is respectfully requested that this rejection be withdrawn.

The time for responding to the Office Action was set for July 8, 2009. Therefore, it is believed that this response is timely. If this is in error, please treat this response as containing a Petition for the Extension of Time under 37 C.F.R. § 1.136(a) for a period sufficient to permit the filing of this paper and charge any corresponding fees to Kenyon & Kenyon's Deposit Account No. 11-0600.

The Applicants hereby make a Conditional Petition for any relief available to correct any defect seen in connection with the filing of this paper, or any defect seen to be remaining in this application after the filing of this paper. The Director is authorized to

charge Kenyon & Kenyon LLP's Deposit Account No. 11-0600 for the Petition fee and any other fees required to effect this Conditional Petition.

Respectfully submitted,

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